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EXAMINER

FERNSTROM, KURT

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 11/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/717,382

Applicant(s)

GINZBURG ET AL.

Examiner

Kurt Fernstrom

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 40-80 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 40-80 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 3712

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 54-66 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 54 recites the limitation that the scanning device is “expandable laterally”; however, no structural features are recited in the specification to enable this function of the scanning device.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 51, 52, 55-66 and 76-77 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The terms “audio/visual equipment” (claim 51), “network access point” (claim 52), “informational material” (claim 76), “marketing material” (claim 77) and “relevant” (claims 76 and 77) are very vague and broad, and does not define what structural

Art Unit: 3712

elements are intended to be encompassed by the claims. Also, with respect to claim 55, the phrase “substantially the same size as an operational MRI scanner” is indefinite because the term “substantially” does not sufficiently define the scope of the claim, and because it is not clear what size an “operational MRI scanner” is, or whether an “operational MRI scanner” is intended to be part of the claimed invention. With respect to claim 56, the phrase “expandable to an extent that at least a portion of the scanner device overhangs the platform” is indefinite because it is not clear how the language pertaining to the platform limits the scope of the claim. Any expandable object can overhang a platform, based on where the object is originally situated with respect to the platform.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 40-43, 47-49, 53, 67-73, 76-77 and 79-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liberman in view of Crowley. Liberman discloses in column 1, line 15 to column 2, line 62 of the specification a system and method for demonstrating and promoting various products comprising the method steps of placing the products and associated educational

Art Unit: 3712

material into a trailer which has a platform and which encloses the platform and the products being displayed, transporting the trailer to a location for viewing by customers, admitting the customers into a viewing area in the trailer and demonstrating the operation of the products.

While Liberman does not specifically disclose the promotion of imaging devices, such devices are a known product. Crowley discloses in column 5, line 38 to column 7, line 59 of the specification one example of a portable imaging device 2. Crowley further discloses in column 13, lines 44-64 that the imaging device is electrically connected to a control console 16, which is control equipment. With respect to claims 48, 49 and 72, Crowley also discloses in column 2, lines 9-14 that the control console is connected to an image display device 35. It would have been obvious to one of ordinary skill in the relevant art to modify the system and method disclosed by Liberman by providing an image scanning device and control equipment for the purpose of demonstrating and promoting the use of that particular equipment. With respect to claims 68 and 71, the steps of performing the method at the claimed location to the claimed viewers would have been obvious in light of the fact that the device being promoted is an image scanning device, which would inherently be of greater interests at a medical facility and to the various viewers claimed in claim 71. With respect to claims 79 and 80, it is well known when demonstrating the operation of a device to use viewers of the demonstration as "models" where necessary. Such a step would have been obvious to one of ordinary skill in the relevant art for the purpose of involving viewers in the demonstration process.

Art Unit: 3712

7. Claims 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liberman in view of Crowley, and further in view of Sheehan. Liberman as viewed in combination with Crowley discloses all of the limitations of claims 44 and 45 the exception of the imaging device and control equipment being connected through infrared wireless means. Infrared wireless means of communication are well known. Sheehan discloses in column 5, lines 26-42 a system and method for providing medical care comprising a medical device 130 and base unit 200 which may be connected through infrared wireless means. It would have been obvious to one of ordinary skill in the relevant art to modify the system disclosed by Liberman as viewed in combination with Crowley by providing infrared wireless connection means to the scanning device and control equipment for the purpose of providing a more compact system which is easier to transport.

8. Claims 46, 50 and 74-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liberman in view of Crowley, and further in view of Lysysanski. Liberman as viewed in combination with Crowley discloses all of the limitations of claims 46, 50 and 75 with the exception of the imaging device and control equipment being simulative. Providing simulations of medical devices, and prerecorded results, are a well known means of demonstrating the proper use of the devices. Lysysanski discloses in column 5, lines 12-62 one example of a simulated imaging device. It would have been obvious to one of ordinary skill in the relevant art to modify the system and method disclosed by Liberman as viewed in combination with Crowley by

Art Unit: 3712

providing a simulative image scanning device and control equipment and prerecorded scan images for the purpose of demonstrating the proper use of the device to the user.

9. Claims 51 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liberman in view of Crowley, and further in view of Wacker. Liberman as viewed in combination with Crowley discloses all of the limitations of claims 51 and 52 with the exceptions of the audio-visual equipment and the network access point. Wacker discloses in column 11 lines 43-51 of the specification a mobile display unit comprising a network access point. It would have been obvious to one of ordinary skill in the relevant art to modify the system disclosed by Liberman as viewed in combination with Crowley by providing a network access point for the purpose of allowing the user to communicate with and receive information from an outside network. Wacker further discloses in column 11, lines 61-65 that audio-visual equipment is provided. It would have been obvious to one of ordinary skill in the relevant art to modify the system disclosed by Liberman as viewed in combination with Crowley by providing audio-visual equipment for the purpose of allowing the user to make a presentation incorporating both audio and video.

10. Claims 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liberman in view of Crowley, and further in view of Migurski. Liberman as viewed in combination with Crowley discloses all of the limitations of claims 54-56 with the exception of the scanner device being laterally expandable. Migurski discloses in Figures 6A-6G and in column 17, line 29 to column 18, line 65 of the specification a system and method for transporting medical equipment to

Art Unit: 3712

remote locations comprising a medical module 97 which is collapsible and expandable to alternatively transport the device and use it. It would have been obvious to one of ordinary skill in the relevant art to modify the system and method disclosed by Liberman as viewed in combination with Crowley by providing expandability to the scanner device for the purpose of allowing the user to transport the device, and then expand it at the remote location.

11. Claims 57-61 and 63-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liberman in view of Crowley and Migurski, and further in view of Fernandez. Liberman as viewed in combination with Crowley and Migurski discloses all of the limitations of claims 57-61 and 63-66 with the exception of the trailer having an opening for an extension or enclosure bay, which is supported by an extension. Fernandez discloses in Figure 2 and in column 1, line 65 to column 2, line 45 of the specification a system and method for transporting equipment to remote locations comprising a trailer 1 which is horizontally expandable by way of retractable floor elements 34, which serve as an extension and also as an enclosure bay. Elements 21 serve as vertically adjustable stands which support the extension. It would have been obvious to one of ordinary skill in the relevant art to modify the system and method disclosed by Liberman as viewed in combination with Crowley and Migurski by providing an extension having stands to the trailer for the purpose of allowing the trailer to accommodate more space during presentations. With respect to claims 61 and 66, while Fernandez does not explicitly disclose that the stand comprises a threaded end which is attached to the extension, Official Notice is taken that it is extremely well known to provide a threaded end to a tubular extension to allow it to be attached



Art Unit: 3712

to a surface such as a platform, and as such would have been obvious for the purpose of providing easily attachable stands.

12. Claim 62 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liberman in view of Crowley, Migurski and Fernandez, and further in view of Wright. Liberman as viewed in combination with Crowley, Migurski and Fernandez discloses all of the limitations of claim 62 with the exception of the overhang panel. Wright discloses in Figure 1 and in column 5, lines 18-40 of the specification a mobile display unit comprising a trailer 16 having an overhang panel 106, wherein the overhang panel serves to partially enclose items being displayed. It would have been obvious to one of ordinary skill in the relevant art to modify the system and method disclosed by Liberman as viewed in combination with Crowley, Migurski and Fernandez by providing an overhang panel for the purpose of partially enclosing the products being displayed.

13. Claim 78 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liberman in view of Crowley, and further in view of Spitzer. Liberman as viewed in combination with Crowley discloses all of the limitations of claim 78 with the exception of the steps of receiving feedback from the customers and modifying various aspects of marketing in accordance with the feedback. Requesting feedback from customers and making various changes to the product and to marketing strategies in accordance with the feedback received is very well known, as disclosed for example in column 1, line 16 to column 2, line 30 of the specification of Spitzer. Spitzer further disclose in column 2, lines 23-26 that a written questionnaire may be used, as claimed in claim 39. It would have been obvious to one of ordinary skill in the relevant art to modify the system and

Art Unit: 3712

method disclosed by Liberman as viewed in combination with Crowley by providing expendability to the trailer for the purpose of allowing the seller to present a more effective presentation.

*Response to Arguments*

14. Applicant's arguments filed on September 5, 2002 have been fully considered but they are not persuasive.

With respect to the rejection of claim 54 under 35 USC 112, para. 1, the specification discloses that the scanner device is laterally expandable . The specification does not, however, describe the structural elements of the device which operate to make the device expandable, and thus does not enable one of ordinary skill in the art to know how, precisely, the device expands laterally.

With respect to the argument that the sysem of Crowley is not "portable", Crowley discloses in column 7, lines 43-46 that the system is "remotely positionable", which means that it is capable of being moved, which makes it portable. It is not clear what structural elements are asserted to be present in the claimed invention which are not present in the cited prior art with respect to "portability."

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge

Art Unit: 3712

generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine Liberman with Crowley comes from the general knowledge that many different types of products are marketed, and the scanning device as claimed is a known product, particularly in light of the fact that the system and method of Liberman is not limited to one particular type of product.

In response to applicant's argument that some of the references are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, each piece of cited prior art is precisely pertinent to the problem with which applicant was concerned. For example, Fernandez has been cited for the expandability of the trailer, because it is drawn to the same problem faced by applicant; namely, how to expand the available size in a transport vehicle to accommodate more people and equipment for a demonstration. Even though Fernandez is directed to demonstration of films, rather than image scanning devices, it is properly combined with Liberman and Crowley because it is pertinent to the problem with which applicant was concerned. The same holds true for each of the cited prior art references, including Sheehan, Lysysanski, Wacker, Migurski, Wright and Spitzer.

Art Unit: 3712

***Conclusion***


15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (703) 305-0303.

KF

November 26, 2002

  
Kien T. Nguyen  
Primary Examiner